

REMARKS

Claims 1, 7-9 and 11-13 are pending in this application. Claims 7 and 9 stand withdrawn. By this Amendment, claim 1 is amended. No new matter is added. Reconsideration and prompt allowance of the pending claims are respectfully requested at least in light of the following Remarks.

I. §112 Rejection

The Office Action rejects claims 1, 8 and 11-13 under 35 U.S.C. §112, second paragraph. In particular, the Office Action asserts that the relationship between the claimed masking material and the claimed adhesive member is not clear. Claims 8 and 11-13 appear to be rejected based on their dependence from claim 1.

Claim 1 is amended responsive to the rejection. Accordingly, withdrawal of the rejection is requested.

II. The Claims Define Patentable Subject Matter

The Office Action rejects claims 1 and 11-13 under 35 U.S.C. §103(a) over Applicants' background art references (ABAR) in view of U.S. Patent Application Publication No. 2001-0000165 to Armstrong, and either JP-A-63-188039 (the '039 application) or JP-A-60-127385 to Nagai et al. ("Nagai"); rejects claims 1 and 11-13 under 35 U.S.C. §103(a) over JP-A-2002-126241 to Norihiko in view of Armstrong and either the '039 application or Nagai; rejects claims 1 and 11-13 under 35 U.S.C. §103(a) over JP-A-2002-126427 to Norihiko ("Norihiko II") and either the '039 application or Nagai; rejects claim 8 under 35 U.S.C. §103(a) over Norihiko, Armstrong and the '039 application or Nagai, and in view of U.S. Patent No. 5,535,355 to Rowland; and rejects claim 8 under 35 U.S.C. §103(a) over Norihiko II, Armstrong, the '039 application and Nagai, and in view of Rowland. The rejections are respectfully traversed.

The applied references fail to disclose and would not have rendered obvious "a grinding step of grinding an outer peripheral portion of the honeycomb stacked body into a predetermined shape after the masking material separating step," as recited in amended claim 1. The Office Action acknowledges that ABAR fails to disclose a grinding step being performed after a masking material separating step but asserts that Armstrong remedies this deficiency. Applicants disagree.

First, contrary to the Examiner's assertion, Armstrong discloses cleaning an abrasive belt/planing surface and does not disclose a method of using a grinding tool to grind and finish several different types of surfaces (see Armstrong, Abstract and paragraph [0001]).

Second, the Office Action's use of Armstrong to reject claim 1 requires hindsight reasoning. In particular, Armstrong discloses that as the abrasive surfaces are used, the abrasive surfaces can accumulate wood, sap, glue and/or burnt wood particles that degrade the abrasive quality of the surface (see Armstrong, paragraph [0019]). The Office Action then makes a leap from this statement asserting that it would have been obvious to remove the masking material prior to a grinding step of a honeycomb filter. However, Armstrong provides no such teaching and in fact discloses an alternate solution to the contamination of the abrasive surface. Armstrong's solution to the contamination of the abrasive surface includes cleaning the surface. Thus, if one of ordinary skill were to combine Armstrong with any of the references, the method would include a cleaning step for cleaning the grinder and would not include a removal of the masking tape prior to the grinding step.

The applied references also would not have rendered obvious "the base sheet is made of a heat shrinkable material which shrinks by heat in the adhesive layer drying step," as recited in claim 1. The Office Action acknowledges that ABAR fails to disclose this feature but asserts that the '039 application and Nagai remedy this deficiency. Applicants disagree.

In particular, although the '039 application and Nagai disclose utilizing heat-shrinking material, neither reference discloses reducing the adhesive quality of a masking tape during an adhesive layer drying step that is similar to the adhesive layer drying step of claim 1. Also, neither reference discloses heat-shrinking a masking material during an adhesive layer drying step in which the adhesive layers between the honeycomb segments are dried.

None of the remaining applied references remedy the deficiencies of ABAR. Therefore, claim 1 is patentable over the applied references.

Dependent claims 8 and 11-13 depend from independent claim 1. Therefore dependent claims 8 and 11-13 are patentable at least for their dependence from claim 1 as well as for the additional features claims 8 and 11-13 recite.

Withdrawal of the rejection is requested.

III. Rejoinder of the Withdrawn Claims

Withdrawn claims 7 and 9 depend from independent claim 1. Therefore, claims 7 and 9 incorporate all of the subject matter recited in claim 1. Accordingly, rejoinder of claims 7 and 9 is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the pending claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Brian K. Kauffman
Registration No. 63,199

JAO:BKK/jls

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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